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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,054	11/06/2001	Merrit N. Jacobs	CDS-255	9036

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PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/993,054

Applicant(s)

JACOBS ET AL.

Examiner

Brian R. Gordon

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10-6-04.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Remarks***

In an effort to expedite the allowance of the claims, the examiner placed a call to Mr. Todd Burns on December 20, 2004. The examiner informed applicant the claims would be allowed if claim 1 would be amended to included the limitations of claim 22 and further amended to delete the phrase "one of the compartments" and both occurrences of the phrase "at least one of". Applicant did not agree to such an amendment.

### ***Response to Arguments***

Applicant's arguments filed August 16, 2004 have been fully considered but they are not persuasive. As to the 102 rejection of claim 18 as based upon Greenfield applicant argues the probe tip of the instant invention is intended to used on an aspirating probe and for mixing liquids. The arguments are moot for they are directed to intended use of the device rather than structural differences.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Furthermore, applicant states the inside diameters of two adjacent cavities are sufficiently unequal. The examiner asserts sufficiency of the dimensions of the diameters is not the only factor in producing such a mixing motion. The ability for the device to perform as such would depend on other variable such as the speed or rate at which a liquid is being aspirated as well as the type of liquid being aspirated. The

dimensions and speed required to produce the desired result will differ from liquid to liquid depending on the viscosity of the liquid. Therefore, to simply imply the dimensions alone produce the mixing motion is not sufficient to determine what dimensions are sufficient to produce a mixing movement of a liquid. The term sufficiently unequal is therefore considered relative. As such the examiner asserts the dimensions of Greenfield may be appropriate to produce such. Furthermore, the mixing is directed to an ability of the device to perform a specific function.

The functional recitations directed to mixing liquids has not been given patentable weight because it is in narrative form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC 112, 6<sup>th</sup> paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.F.279.

It has been held that the recitation that an element is "adapted to" or "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Applicant further states Greenfield does not teach or suggest a probe tip that is adapted to fit onto an aspirating probe. While applicant is allowed to be his own lexicographer and may refer to the instant invention as a probe tip, the examiner asserts the slide assert the coupling of Greenfield is structurally equivalent to that as claimed by applicant in claim 18. The abstract of Greenfield discloses "A glass slide enclosure assembly is described with which fluid couplings can be conveniently made between the enclosure and elongate plastic tubes." The examiner has rejected applicant claims based upon the structure of the fluid coupling used within the slide assembly. Applicant states the instant invention is adapted to fit an aspirating probe. The examiner asserts

Art Unit: 1743

the fluid coupling of Greenfield may be attached to a plastic tube such as an aspiration probe.

As to claim 20, the examiner directs applicant's attention to Figure 5 (given herein). It is clearly shown in the figure plastic coupling 26, may be manufactured to any desired shape/diameter to couple together various sizes of conduits. The element 26 is very similar to applicants Figure 8. It is clearly seen in the figure that element 26 does comprise transition zones of unequal diameters at each end for the insertion of different sized conduits.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiment in which there is only one transition zone which increases in diameter outward and the second transition zone decreasing in diameter must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

1. Claim 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "sufficiently unequal" in claim 18 is a relative term which renders the claim indefinite. The term "sufficiently unequal" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The ability for the device to perform as such would depend on other variable such as the speed or rate at which a liquid is being aspirated as well as the type of liquid being aspirated. The dimensions and speed required to produce the desired result will differ from liquid to liquid depending on the viscosity of the liquid. Therefore, to simply imply the dimensions alone produce the mixing motion is not sufficient to determine what dimensions are sufficient to produce a mixing movement of a liquid. The term sufficiently unequal is therefore considered relative.

***Claim Rejections - 35 USC § 102***

Art Unit: 1743

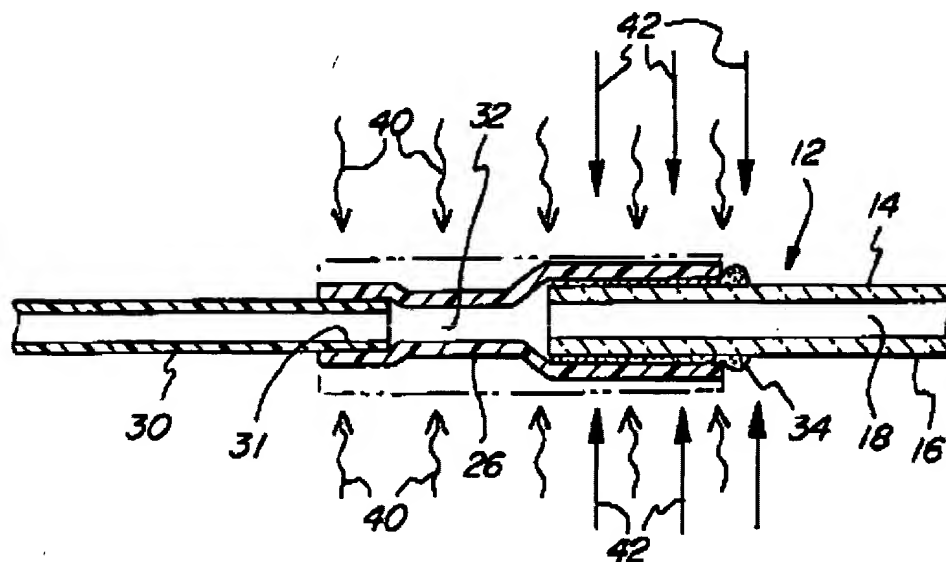
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 18-19, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenfield US 5,891,397.

Greenfield discloses a connecting tube device 32 that meets all the limitations of the claim. The tube as seen in Figure 5, comprises 3 cavities formed by a wall, a middle cavity that transitions outward into two adjacent cavities.



**FIG. 5**

**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1743

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greenfield US 5,891,397.



Greenfield discloses a connecting tube device 26,32 that meets all the limitations of the claim. The tube as seen in Figure 5, comprises 3 cavities formed by a wall, a middle cavity that transitions outward into two adjacent cavities.

Greenfield does not specifically recite the plastic tube 26 forms an end cavity with a diameter at least equal to three times the value of the smaller diameter. .

While Figure 5 appears to show tube 26 as meeting the limitation, it would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that the plastic tube 26, 32 may also be formed or heat shrunk to accommodate or allow for the coupling of various sizes of conduits.

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greenfield as applied to claims 18-19, and 21 above, and further in view of De Vaughn et al. US 5,580,529.

Greenfield discloses a connecting tube device 26, 32 that meets all the limitations of the claim. The tube as seen in Figure 5, comprises 3 cavities formed by a wall, a middle cavity that transitions outward into two adjacent cavities.

Greenfield does not disclose the fluid coupling system in combination with an aspiration probe.

De Vaughn et al. disclose baffle assembly 23 is preferably formed as by an injection molded, disposable adapter (of a thermoplastic material similar to the disposable pipette tips) removably mounted between both the reservoir tip and the pipetter assembly (FIG. 3) so that aspiration of any liquid caused by the pipetter must flow through the adapter. Hence, before each new fluid sample is pipetted, the

Art Unit: 1743

technician could simply replace and discard both pipette tip 16 and adapter assembly 23.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that the plastic fluid coupling of Greenfield may be employed in the same manner as the adapter of De Vaguhn et al. to couple a tip and aspiration probe of different diameters together in order to have a disposable tip assembly to reduce cross contamination of fluids.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Art Unit: 1743

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

brg

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700